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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,535	04/20/2004	Nathan Cantlon	JORC122790	3888
26389	7590	10/19/2005	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			WILLIAMS, JAMILA O	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,535

Applicant(s)

CANTLON, NATHAN

Examiner

Jamila O. Williams

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-20-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of prior U.S. Patent No. 6,935,637 and claims 1-20 of prior U.S. Patent No. 6,722,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are related as being genus/species inventions (or broad/more specific inventions). A review of the patented file record indicates that there are no apparent reasons why applicant was prevented from presenting and fully prosecuting a generic (or broad) claim during the examination of the above-mentioned patents. Since the patentee has voluntarily elected to obtain early issuance of claims directed to a species (or more specific invention) and to pursue the prosecution of the genus (broad) in a continuation, the court in *In re Goodman*, 29 USPQ 2d 2010 (Fed Cir. 1993) held that absent a terminal disclaimer, the patentee would gain an unjust extension of the 17-year term of

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the species when the broad genus is issued. Consistent with the holdings of *In re Goodman*, supra, a terminal disclaimer is required before this application may be passed to issue.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-7, 12 and 18-21, 24, 25, 28-31 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by 6,325,393 to Chen ('393). Regarding claims 1, 7, 11, 19, the workpiece connector includes a shaft formed by the longitudinal hole (42) into which a workpiece stem is selectively received (80) and having a sliding collar (60). The locking assembly includes, ball (45) and countersink (48) of the tube (40). The centering assembly includes, the interior walls (42, for example) of the tube (40). As to claims 4,14, the locking assembly or means within the channel of the shaft has at least a first ball received in a cavity of the shaft (see cavity 82 and ball 45). As to claims 2,8,12 the locking assembly, i.e., the ball (45), is automatically reciprocated between a locked and an unlocked position when the workpiece (80) is inserted into the workpiece connector. As to claim 13, the follower (30) serves as the claimed biased pin assembly

and includes first and second sections (34) and (32) being biased to selectively eject the workpiece from within the channel. As to claims 3, the centering assembly, as detailed above, automatically and simultaneously centers the workpiece within the channel, or hole, of the workpiece connector as the locking assembly or means is displaced into locking engagement.

Claim Rejections - 35 USC § 103

Claims 5-6,9-10,15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen ('393) in view of Wienhold ('194). Chen discloses all of the elements of the claims as applied to claim 1 above. Chen differs from the claimed invention in that Chen does not disclose a centering assembly including at least one ball and more specifically including a plurality of balls symmetrically oriented around the workpiece. Wienhold shows it to be old in the art to take advantage of strategically placed balls (28 and 30, for example) to serve as part of both a centering and locking mechanism to hold the shank portion of a tool bit within a chuck assembly (see abstract in Wienhold). In view of the patent to Wienhold, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device to Chen by providing plural at least one or detent balls around the circumference of the shank of the workpiece, between the workpiece and the collar (60), for the purpose of not only serving as part of the locking mechanism, but also to help center the shank.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Mon-Fri 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JW 10-5-2005



BOYER D. ASHLEY
PRIMARY EXAMINER